

REMARKS

In response to the April 25, 2006 Office Action, Applicants respond to the Examiner's detailed action with the following remarks.

Claim Rejections – 35 USC §102

In response to the Examiner's rejection of Claims 1 – 8 and 10 – 20 under 35 U.S.C. §102(e) as being anticipated by U.S. 6,610,116 ("Avery"), Applicant respectfully disagrees. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Each and every limitation of independent Claims 1, 13, and 17 of the present invention, and the claims dependent therefrom, are not taught by Avery.

The Examiner rejects the present invention on the basis that Avery first teaches "an air cleaner (10), a lower retaining segment (18), an upper retaining segment (12), and a filtration member (20)..." Avery, in fact, teaches an air cleaner (10), having a first housing section (18), a clamp sleeve (12), and a filtration member (20) (*See* Fig. 3). Respectfully, the Examiner's characterization of Avery's clamp sleeve (12) as equivalent to the upper retaining segment of the present invention is inaccurate because the first housing section (18) and the clamp sleeve (12) of Avery **do not cooperate to retain anything**, unlike the upper and lower retaining segments of the present invention (*See* Column 8, lines 53 – 59).

Moreover, the present invention claims a "filtration member having an upper filtration member end and a lower filtration member end, wherein said upper filtration member end is engaged with said upper retaining segment and said lower filtration member end is engaged with said lower retaining segment." Figure 4 of Avery shows that Avery's filtration member (20) is **clearly not engaged** with (in the Examiner's words) "upper retaining segment (12)" and "lower retaining segment (18)."

As a threshold matter, Avery fails to teach that filtration member 20 has “an upper filtration member end and a lower filtration member end.” The independent Claims of the present invention expressly include this limitation.

Even if, *arguendo*, the filtration member (20) of Avery has an upper filtration member end and a lower filtration member end, the filtration member (20) of Avery **does not come in any contact whatsoever** with what the Examiner describes as Avery’s “upper retaining segment (12)” (*See* Avery, Fig. 4, and lines 62 – 66 of Column 7). The claims of the present invention are limited to an air filter where an upper filtration member end is engaged with an upper retaining segment. **No part of filtration member (20) comes in contact with what the Examiner terms the “upper retaining segment (12),”** (*See* Avery, Figs. 1, 3, and 4). Respectfully, the Examiner’s reliance on Avery must fail on this basis alone.

Moreover, even assuming that Avery’s filtration member (20) has a “lower filtration member end” – this lower portion of filtration member (20) comes in contact with “air cleaner (22),” **and not** “lower retaining segment (18).” The claims of the present invention are limited to an air filter where a lower filtration member end is engaged with said lower retaining segment. If anything, the **upper** end of filtration member (20) of Avery comes in contact with what the Examiner terms “lower retaining segment (18)”, not the lower end. Avery simply does not teach this limitation.

The Examiner further argues that Avery teaches a “lower retaining segment (18) having an air cleaner (22) coupling means (52) for coupling air cleaner (22) to the lower retaining means (18).” In contrast, the present invention claims a lower retaining segment further comprises an air cleaner coupling means for coupling said air cleaner to an air cleaner receptacle; and said lower retaining segment and said air cleaner coupling means are integrally formed from a single material.

First, the “coupling means (52)” referred to by the Examiner is taught in Avery as part of “air cleaner (22),” (*See* Fig. 3), **and not as any portion of “lower retaining segment (18).”** The Avery reference numeral 52 on Figure 3 clearly is not located on “lower retaining segment (18).” **As a result, it is impossible that the “lower retaining segment (18)” and “coupling means**

(52)" are integrally formed from a single material. Avery does not teach any of these limitations found in the claims of the present invention. Moreover, one skilled in the art would not consider Avery's "second housing section (22)" to be equivalent with an "air cleaner receptacle" as claimed by the present invention. The "coupling means" referred to by the present invention indicate a means to connect the entire air cleaner device **to a separate and distinct receptacle.** In contrast, the "coupling means (52)" of Avery connects one portion of the air cleaner device **to another portion of the same air cleaner device.** They are not equivalent means.

Finally, the Examiner states that Avery teaches that "lower retaining segment (18)" and "air cleaner portion (22)" can be "permanently attached to one another and the whole air cleaner unit can be disposable." This statement is not supported by Avery. Avery teaches in lines 54 – 57 of Column 7 that "...the first and second housing sections may be permanently attached to one another and the air filter system of the present invention may then be considered disposable." Thus, Avery teaches that just the first and second housing sections and the filter medium are disposable. According to the Examiner's own characterization, this "disposable" unit does not include the "upper retaining segment (12)". In contrast, the present invention claims that the entire "air cleaner unit is disposable," and pursuant to the independent claims, the air cleaner unit includes all of a lower retaining segment, an upper retaining segment, and a filtration member.

It should be noted that the advantage to the present invention is a fully disposable air filter with no removable parts. The lower threaded portion of the present invention is generally embodied as molded polyurethane, and the threads are cut such that no thread sealant is required. In contrast, Avery teaches multiple removable parts, and specifies that gaskets may be used, or cementing or welding may be performed to avert leakage (Column 9, lines 18 – 28).

For the reasons noted above, the Examiner's reliance on Avery is misplaced. As a result, Applicant respectfully submits that Claims 1 – 8 and 10 – 20 are therefore allowable.

In response to the Examiner's rejection of Claims 1 – 8 and 10 – 20 under 35 U.S.C. §102(b) as being anticipated by U.S. 6,447,565 ("Raszkowski"), Applicant respectfully disagrees. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Each and every limitation of independent Claims 1, 13, and 17 of the present invention, and the claims dependent therefrom, are not taught by Raszkowski.

As discussed above with respect to Avery, Independent Claims 1, 13, and 17 of the present invention claim a "filtration member having an upper filtration member end and a lower filtration member end, wherein said upper filtration member end is engaged with said upper retaining segment and said lower filtration member end is engaged with said lower retaining segment." Figure 4 of Raszkowski shows that Raszkowski's filtration member (18) is **clearly not engaged** with (in the Examiner's words) "upper retaining segment (24)" and "lower retaining segment (22)."

As a threshold matter, Raszkowski fails to teach that filtration member 18 has "an upper filtration member end and a lower filtration member end." The independent Claims of the present invention expressly include this limitation.

Even if, *arguendo*, the filtration member (18) of Raszkowski has an upper filtration member end and a lower filtration member end, the filtration member (18) of Raszkowski **does not come in any contact whatsoever** with what the Examiner describes as Raszkowski's "lower retaining segment (22)" (*See* Raszkowski, Fig. 4, and lines 61 – 66 of Column 2). The claims of the present invention are limited to an air filter where a lower filtration member end is engaged with a lower retaining segment. **No part of filtration member (18) comes in contact with what the Examiner terms the "lower retaining segment (22),"** (*See* Raszkowski, Figs. 2 and 4). Respectfully, the Examiner's reliance on Raszkowski must fail on this basis alone.

It should be noted that the advantage to the present invention is a fully disposable air filter with no removable parts. The lower threaded portion of the present invention is generally embodied as molded polyurethane, and the threads are cut such that no thread sealant is required. In contrast, Raszkowski teaches

multiple removable parts, and specifies that the invention may be press fitted, which may allow for leakage and even failure (Column 3, lines 14 – 24).

For the reasons noted above, the Examiner's reliance on Raszkowski is misplaced. As a result, Applicant respectfully submits that Claims 1 – 8 and 10 – 20 are therefore allowable.

The Applicant further notes that the Examiner has not addressed any of the further limitations found in the dependent claims of the present invention. Neither Avery nor Raszkowski teaches the limitations found in the dependent claims, and rejection of the dependent claims is improper under MPEP 707.07(d) (stating that a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group). As a result, Applicant requests a Notice of Allowance be issued for those claims.

Applicants appreciate the opportunity to call the Examiner but believe that this amendment to the claims and the forgoing remarks fully address the issues raised by the Examiner. On the other hand, the Examiner is invited to call the undersigned attorney if he has any matters to address that will facilitate allowance of the application.

In the event that Applicant has overlooked the need for an extension of time, additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any changes be made to Deposit Account No.: 50-3010.

Respectfully submitted,

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